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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/324,182	06/02/99	SHAH	A 2870/155

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HM22/1010

EXAMINER

PULLIAM, A

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/324,182

Applicant(s)

SHAH ET AL.

Examiner

Amy E Pulliam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the request for a CPA, Request for an Extension of Time, and the Preliminary Amendment B, received August 3, 2001.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7-19, 21, 22, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,523,091 to Pastour *et al.* (hereinafter Pastour). Pastour discloses a cosmetic emulsion composition which comprises a silicone, a gelling agent, and an emulsifying agent (abstract). Pastour teaches that the emulsifying agent can be dimethicone and mixtures thereof (c 1, l 45). Pastour further teaches that the silicone can be a cyclomethicone (c 3, l 18). Pastour also allows for additives such as vegetable oils such as jojoba oil, apricot oil, grape seed oil, and others (c 5, l 1-13), and he also includes surfactants (c 5, l 20), and pigments (c 5, l 44). Pastour also teaches that the composition can comprise active ingredients such as plant extracts, and these can be present from between 1 and 15%. Further, the cosmetic can contain fillers of plants, either inorganic or synthetic, such as starch or nylon (c 6, l 3-11). Lastly, Pastour teaches that his composition can be in the form of a mascara.

Applicant's arguments have been fully considered but are not found persuasive. Applicant argues that their invention contains a whole unprocessed fruit or vegetable extract prepared using seedless but otherwise substantially unfiltered fruit of vegetable. Applicant's further claim that the word extract is defined to have a special meaning. Additionally, applicant argues that their extract is non-filtered. First, the cited reference does not specify that their extract must be filtered. Again, the examiner relies on the above citation which allows for the inclusion of plant extracts, with no requirement for filtration. Second, the Office does not have the facilities for examining and comparing applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products are functionally different than those taught by the prior art and to establish patentable differences. See *Ex parte Phillips*, 28 U.S.P.Q.2d 1302, 1303 (PTO Bd. Pat. App. & Int. 1993), *Ex parte Gray*, 10 USPQ2d 1922, 1923 (PTO Bd. Pat. App. & Int.) and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). There is no evidence that the extract referred to in the cited reference is not the same extract referred to by applicant.

Additionally, applicant's claim recites that the extract is processed, but provides no limitations discussing what the processing steps might entail. Although the claims are read in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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The examiner is permitted to apply the broadest interpretation to the claims. Therefore, it is the position of the examiner that absent any specific limitations, a processing step can be interpreted very broadly. Furthermore, although there is no evidence that the reference's extract is filtered, even if it was, the inclusion of the word processed in applicant's claims would still allow the reference to read on applicant's instant claims.

Furthermore, based on applicant's use of the word extract, and the prior art's teaching the presence of an extract, it remains the position of the examiner that the reference applies against the instant claims.

Furthermore, it is unclear to the examiner what is unexpected about applicant's claimed product. It is the position of the examiner that there is no functional difference between applicant's claimed mascara and the mascara disclosed by Pastour. Additionally, applicant has demonstrated no unexpected results. Specifically, on page 8 of applicant's specification, there is a discussion of a study using the claimed formulation. For each of the tested characteristics (natural appearance, comfort on the lashes, not causing lashes to be pointed, lack of clumping), 80% of the women said the mascara was equal to or better than their current mascara. This data can be interpreted to mean that 80% or more of the women thought the claimed formulation performed the same as the current formulation, therefore rendering no unexpected results. Therefore, the above rejection is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,523,091 to Pastour *et al.*. Pastour is discussed above as disclosing a cosmetic composition, which can be a mascara, and which can contain actives such as plant extracts. Pastour does not teach the specific percent of extract as claimed in claim 3. However, he does teach a very small and similar amount of extract. Further, Pastour does not teach the specific natural non-plant fiber as claimed by applicant. However, he does teach the inclusion of inorganic and synthetic fillers in general. Pastour does not teach the specific surfactant as claimed by applicant. It is the position of the examiner that the exact percent of the extract, the specific inorganic additives, and the specific surfactant are all limitations which would be routinely determined by one of ordinary skill in the art, as being suitable, based on the generic teachings in Pastour. Furthermore, the examiner reads the teaching of plant extract to include any and all plants, as Pastour does not differentiate. Therefore, this teaching includes both vegetables and fruits. One of ordinary skill in the art would have been motivated to make a mascara composition based on Pastour's teachings, which comprises any plant extract, and also contains inorganic or synthetic fillers and surfactants. The expected result would be a successful mascara composition, which has the beneficial qualities of Pastour's

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composition, which are ease of application, softness, uniformity, hold, and good sensory qualities. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's arguments have been considered but are not found persuasive for the reasons stated above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is (703) 308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

aep
October 5, 2001

THURMAN K PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600